

REMARKS/ARGUMENTSDiscussion of the Prior Office Action

In the office action in the original case dated January 30, 2001, original claims 5 and 21 were rejected as being anticipated under 35 U.S.C. 102(a) over the admitted prior art (APA).

According to the Examiner:

"Claims 5 and 21 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by the first six figures of this application, as indicated above.

"When "CORP A" is the Internet Service Provider, claims 5 and 21 are clearly anticipated. Specifically, in figure 5 there is a central database (the database directly connected to GRS), maintaining at least one AAA at the PoP, and configuring a database associated with the AAA service (the database directly connected to the AAA). Since CORP (A) and CORP (B) are viewed as part of the Internet Service Provider, there was a plurality of AAAs.

"The above cited rejection is in the spirit of compact prosecution. Depending on which, if any, of the figures used in the above rejection, the rejection may or may not be moot."

In the same office action, original claims 5 and 21 were rejected under 35 U.S.C. Sec. 102(e) as being anticipated by Zhang et al. (USP 6,119,160). According to the Examiner:

"Claims 5 and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Zhang et al. (6,119,160) (eg., see figures 1, 3, 4, Abstract, Col. 3 (line 31-etc seq.), specifically figure 4 where each of the access points (152) are housed in one Internet Service Provider as covered in col. 9 (line 60-etc seq.)). Each AAA was anticipated to have its own database as indicated in col. 3 (line 45-etc seq.) with at least one central database in the system."

The Examiner indicated that original application claims 1-4, 6-20 and 22-32 were allowable. Claims 6 and 22 were amended to incorporate the limitations of claims 5 and 21 and claims 5 and 21 were cancelled without prejudice resulting in the claims of the patent now under Reissue. No substantive arguments were made concerning the claims.

Discussion of the Proposed New Reissue Claims with respect to the Recapture Rule

MPEP Section 1412.02 codifies the "Recapture Rule" which generally bars an applicant for a reissue patent from "recapturing" claimed subject matter which was surrendered in an application to obtain the original patent. The recent case of Ex parte Eggert, 67 USPQ 2d 1716 (BPAI, 2003) applied the following rule:

In both Mentor [Mentor Corp. v. Colorplast Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993)] and Ball [Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984)], the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim (the surrendered subject matter) in all aspects, the recapture rule bars the claim; (2) if it is narrower (than the surrendered subject matter) in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader (than the surrendered subject matter) in some respects, but narrower (than the surrendered subject matter) in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to (a) prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

In the present case, the surrendered subject matter consisted of original claims 5 and 21, nothing more. These claims originally read as follows:

Original Claim 5: A method of managing network access to a data communications network, said method comprising:
maintaining a central database;
maintaining at least one authentication, authorization and accounting (AAA) service at a point of presence (PoP) of the data communications network; and
configuring a database associated with the AAA service from the central database.

Original Claim 21: A method of managing network access to a data communications network, said method comprising:
maintaining a central database;
maintaining a plurality of authentication, authorization and accounting (AAA) services at a point of presence (PoP) of the data communications network; and
configuring databases associated with the AAA services from the central database.

In the 102(a) rejection the Examiner alleged that the limitations of original claims 5 and 21 were met because FIG. 5 shows "configuring" a single AAA's database from a GRS at the PoP and if the CORPA and CORPB domains are taken into account, a network with a plurality of AAA services (not shown being configured by the GRS) is shown.

In the 102(e) rejection the Examiner alleged that Zhang et al. FIG. 4 teaches a PoP with multiple AAA services each with its own database and a central AAA database.

According to the MPEP at Sec. 1412.02 "A reissue will not be granted to 'recapture' claimed subject matter which was surrendered in an application to obtain the original patent. {citations omitted}"

There is a two step test. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. One normally looks to the prosecution history for arguments and changes made in response to a prior art rejection. Where a claim is broadened, the examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution.

According to the MPEP: "If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation

relates to subject matter previously surrendered by applicant, and impermissible recapture relates to subject matter previously surrendered by applicant, and impermissible recapture exists."

In the present reissue application, it is apparent that no substantive amendments were made to the claims during prosecution. Claims 5 and 21 were cancelled, but all other claims were deemed allowable in the first office action. It is also apparent that no substantive argument with respect to the prior art was made during prosecution. Certain claims were indicated to be allowable. The non-allowable claims were cancelled and the allowable claims (some incorporating the cancelled subject matter) proceeded to issue. Accordingly, this portion of the MPEP is not invoked by the present reissue application.

According to the MPEP: "The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or broader in scope than, those claims cancelled from the original application to obtain a patent. {citation omitted}."

The following Table explains how the issued claims sourced from the original claims:

ISSUED CLAIM	ORIGINALLY
1 - IND	5 + 6
2 - DEP: 1	7
3 - DEP: 2	8
4 - DEP: 2	9
5 - DEP: 2	10
6 - IND	21 + 22
7 - DEP: 6	23
8 - DEP: 7	24
9 - DEP: 7	25
10 - DEP: 7	26
11 - IND	11

12 – DEP: 11	12
13 – DEP: 11	13
14 – DEP: 11	14
15 – IND	17
16 – DEP: 15	18
17 – DEP: 15	19
18 – DEP: 15	20
19 – IND	27
20 – DEP: 19	28
21 – DEP: 19	29
22 – DEP: 19	30
23 – IND	1
24 – DEP: 23	2
25 – DEP: 23	3
26 – DEP: 23	4
27 – IND	15
28 – DEP: 27	16
29 – IND	31
30 – DEP: 29	32

Thus only issued claims 1 – 10 have any relationship whatsoever to the cancelled claims.

Discussion of the New Reissue Claims

The new reissue claims include reissue claims 31 – 73. Of these claims, 31, 38, 43, 47, 51, 55, 59, 61 and 63 – 73 are independent claims. The independent claims will now be addressed in detail. All of the new dependent claims depend from new independent claims and are therefore narrower by definition. Accordingly they will not be addressed in detail, however, they are allowable for at least the reasons that their parent independent claims are allowable.

Reissue Claim 31 is narrower in at least one respect from that of cancelled claim 5. It requires at least two PoPs with AAAs, the AAAs configured from a central database. This is clearly narrower than cancelled claim 5 and narrower than the cited art.

According to the MPEP: "Reissue claims that are broader in some aspects and narrower in others vis-à-vis claims cancelled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. {citations omitted}. If the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.... {citation omitted}."

Reissue Claim 31 is narrower than cancelled original claim 5. It is narrower at least insofar as it contains limitations directed to multiple PoPs with remote AAAs configured from a central database. It is broader than original claim 6 (which became issued claim 1) insofar as it does not specify the precise mechanism by which information is transmitted to configure the AAAs. Original claim 1 was a broad claim which the Examiner determined included in its scope the subject matter of Zhang et al. and the Admitted Prior Art (APA), i.e., AAAs configured at a PoP from a central database. Reissue claim 31 is limited to a multi-PoP implementation not disclosed or taught by the APA or by Zhang et al. and is thus narrower in scope than original claim 5. Accordingly, the surrendered subject matter, single PoP implementation, is not recaptured by the proposed reissue claim 31 and this claim is thus in condition for allowance.

Reissue claims 32 – 37 all depend from Reissue claim 31 and are allowable for at least the same reasons referred to above.

Reissue claim 38 is narrower than cancelled original claim 21 for the same reasons stated with respect to claim 31 above. Accordingly it is allowable as well.

Reissue claims 39 – 42 all depend from Reissue claim 38 and are all allowable for at least the same reasons referred to above.

Reissue claim 43 is similar to issued claim 11 except that it does not require a particular method of information transport such as the subscriber-publisher system described in claim 11. It is thus broader than claim 11, however, issued claim 11 was not subject to rejection or argument, therefore the recapture rule does not apply. This claim is in condition for allowance.

Reissue claims 44 – 46 depend from reissue claim 43 and are all allowable for at least the same reasons referred to above.

Reissue claim 47 is similar to issued claim 15 except that it is narrower in that it requires the database checked for a remote AAA service to be associated with the one AAA service used. This claim was not subject to rejection or narrowing or argument, therefore the recapture rule does not apply. This claim is in condition for allowance.

Reissue claims 48 – 50 depend from reissue claim 47 and are all allowable for at least the same reasons referred to above.

Reissue claim 51 is similar to issued claim 19 except that it is broader in that it does not

require a specific form of information transport. This claim was not subject to rejection or narrowing or argument, therefore the recapture rule does not apply. This claim is in condition for allowance.

Reissue claims 52 - 54 depend from reissue claim 51 and are all allowable for at least the same reasons referred to above.

Reissue claim 55 is similar to issued claim 23, though it is narrower in that it contains the additional limitation regarding transmitting of updating information to the AAA service. This claim was not subject to rejection or narrowing or argument, therefore the recapture rule does not apply. This claim is in condition for allowance.

Reissue claims 56 - 58 depend from reissue claim 55 and are all allowable for at least the same reasons referred to above.

Reissue claim 59 is similar to issued claim 27, though it is broader in that it contains a limitation to a transmitter rather than a publisher to accomplish the information transport function. This claim was not subject to rejection or narrowing or argument, therefore the recapture rule does not apply. This claim is in condition for allowance.

Reissue claim 60 depends from reissue claim 59 and is allowable for at least the same reasons referred to above.

Reissue claim 61 is similar to issued claim 29, though it is broader in that it contains a limitation to a transmitter rather than a publisher to accomplish the information transport function. This claim was not subject to rejection or narrowing or argument, therefore the recapture rule does not apply. This claim is in condition for allowance.

Reissue claim 62 depends from reissue claim 61 and is allowable for at least the same reasons referred to above.

Reissue claims 63 and 64 are both independent and recite subject matter generally similar to issued claims in means plus function format.

Reissue claim 65 is independent and claims the accounting aspect of the invention not previously claimed in means plus function format.

Reissue claim 66 is independent and recites subject matter generally similar to issued claims.

Reissue claim 67 is independent and recited subject matter generally similar to issued claims in means plus function format.

Reissue claims 68 – 73 are independent claims directed to two-PoP versions of the invention.

For the foregoing reasons, claims 63 – 73 are allowable as well.

Amendments to the Specification

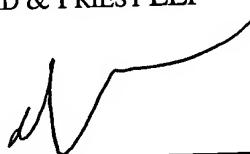
A number of minor amendments are made to the specification. They include matters noted in the Certificate of Correction as were additional typographical and minor grammatical errors noted in preparing the reissue application. No new matter is introduced thereby.

Amendments to the Issued Claims

A number of the issued claims have been amended. These amendments are all to correct obvious typographical errors noted in the preparation of this application or to correct matters previously noted in the certificate of correction.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1698.

Respectfully submitted,
THELEN REID & PRIEST LLP



Dated: October 2, 2003

David B. Ritchie
Reg. No. 31,562

THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
Phone: (408) 292-5800
Fax: (408) 287-8040